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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,909	11/24/2003	Roland Janzen	DCS-9151	5291
34500	7590	01/25/2008		
DADE BEHRING INC. LEGAL DEPARTMENT 1717 DEERFIELD ROAD DEERFIELD, IL 60015			EXAMINER: VENC, DAVID J	
			ART UNIT	PAPER NUMBER
			1641	
			MAIL DATE	DELIVERY MODE
			01/25/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/720,909

Applicant(s)

JANZEN ET AL.

Examiner

David J. Venci

Art Unit

1641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on October 30, 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 and 14-21 is/are pending in the application.
- 4a) Of the above claim(s) 1-6, 9-12 and 14-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7 and 8 is/are rejected.
- 7) ☒ Claim(s) 7 is/are objected to.
- 8) ☒ Claim(s) 1-12 and 14-21 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submissions filed on July 26, 2007, and May 3, 2007 are entered.

Applicants have not made any claim amendments since Applicants' amendment filed November 22, 2006.

Claims 1-12 and 14-21 as filed on November 22, 2006, are pending.

### ***Election/Restrictions***

Examiner acknowledges Applicants' election of Invention II, claims 7 and 8. Applicants did not distinctly and specifically point out the supposed errors in the restriction requirement. Therefore, Applicants' election is treated as an election without traverse. See MPEP § 818.03(a). Claims 1-6, 9-12 and 14-21 are directed to non-elected inventions and are withdrawn from consideration pursuant to 37 CFR 1.142(b).

Claims 7 and 8 as filed on November 22, 2006, are under examination.

*Claim Objections*

Claim 7 is objected to because of punctuation and formatting errors (e.g., too many "(2)", too many semicolons, not enough periods). Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 7 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Bittner & Rowold, *Electrotransfer in Equipment Containing Buffer*, in CRC HANDBOOK OF IMMUNOBLOTTING OF PROTEINS, Vol. 1, Chapter 4.3.1, pp. 69-77, O.J. Bjerrum & N.H.H. Heegaard, Eds., CRC Press, Inc. (1988).

Bittner & Rowold describe a reagent intended to capture free binding species in a fluid medium containing both free binding species and binding species attached to a substrate, wherein the binding species attached to the substrate is intended to disassociate from the substrate, the reagent comprising:

a fluid medium (see p. 72, Step 2—Electroblotting, "The buffer tank should contain sufficient precooled buffer to cover the filter sandwich"; see *a/so*, Fig. 1A, "Buffer Tank") containing:

1. a substrate having binding species attached to the substrate (see p. 69, second paragraph, first sentence, "proteins to be eluted from gels"; see *a/so*, Fig. 1B, "Gel"); and
2. a porous material (see Fig. 1B, "Immobilizing Filter") having:
  - a. permeability to free binding species (see Fig. 1B, "Immobilizing Filter") (emphasis added); and

- b. affinity for free binding species within the pores of the porous material (see p. 74, third full paragraph, second sentence, "immobilization throughout the coarser covalent matrices"; see *also*, Fig. 1B, *noting* a thick "Immobilizing Filter");

wherein the porous material is not intended to have permeability to said substrate (see Fig. 1B, *noting* that Fig. 1 fails to show the "Gel" permeating into the "Immobilizing Filter").

Claims 7 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Skold *et al.* (US 5,039,607).

Skold *et al.* describe a reagent intended to capture free binding species in a fluid medium containing both free binding species and binding species attached to a substrate, wherein the binding species attached to the substrate is intended to disassociate from the substrate, the reagent comprising:

a fluid medium (see col. 20, line 5, "the first and second bibulous strips can be immersed in a developer solution") containing:

1. a substrate having binding species attached to the substrate (see col. 19, lines 59-61, "the second reagent all becomes bound to the first bibulous member"); and
2. a porous material (see col. 19, lines 61-62, "the second bibulous strip") having:
  - c. permeability to free binding species (see col. 19, lines 61-62, "the second bibulous strip") (emphasis added); and

- d. affinity for free binding species within the pores of the porous material (see col. 19, lines 54, "captured by the antibody on the second bibulous strip");

wherein the porous material is not intended to have permeability to said substrate (see entire document, *noting* that Skold *et al.* fail to show the "first bibulous member" permeating into the "second bibulous member").

***Response to Arguments***

In prior Office Action, Examiner raised objections to the disclosure for various informalities. Upon reconsideration of Applicants' persuasive arguments presented in the replies filed November 22, 2006, and May 3, 2007, these objections are withdrawn.

In prior Office Action, Examiner did not reject claims 7 and 8 pursuant to any statute because claims 7 and 8 were withdrawn from consideration in the prior Office Action. Claims 1-6 and 14-16 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for various reasons. Herein, claims 1-6, 9-12 and 14-21 are withdrawn from consideration pursuant to 37 CFR 1.142(b) as being directed to non-elected inventions. Applicants' arguments presented in the reply filed November 22, 2006, and reiterated in the reply filed May 3, 2007, will be reconsidered upon rejoinder of the affected claims.

***Conclusion***

No claims are allowable at this time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Venci whose telephone number is 571-272-2879. The examiner can normally be reached on 08:00 - 16:30 (EST). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on 571-272-0823. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

David J Venci  
Assistant Examiner  
Art Unit 1641



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djv